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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,866	09/20/2000	Brian J. Brown	S63.2-9397	1548
490	7590	07/06/2005	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			PREBILIC, PAUL B	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,866

Applicant(s)

BROWN ET AL.

Examiner

Paul B. Prebilic

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57,67,79,80,83,84 and 89-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57,67,79,80,83,84,89-96 and 98-102 is/are allowed.
- 6) ☐ Claim(s) 97 and 103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Terminal Disclaimer

The terminal disclaimer filed on April 21, 2005 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 6,818,014 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 97 and 103 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 97, the new range of "the struts of at least one cylindrically shaped segments are longer than the struts of an adjacent undulating circumferential band" lack original support because the application as filed did not support any number of bands having different strut lengths. In particular, the originally filed specification only disclosed that two (2) circumferential bands can have longer struts; see Figure 4 and page 5, lines 4-9 for the entire disclosure in this regard. For this reason, the open ended range of "at least one" clearly lacks original support; see MPEP 2163.05 (III), which is incorporated herein by reference.

With regard to claims 97 and 103, the present claims have a limitation that is outside the scope of the limitation as it was originally contemplated. In particular, the original specification only disclosed that the cylindrically shaped end segments could be longer for "providing a more gradual transition from the native vessel to the support structure of the stent"; see page 5, lines 7-8 of the original specification. In fact, Figure 4 and page 5, lines 4-9 appear to constitute the entire disclosure with respect to varying the length of struts from one segment to another. In this disclosure, the specification is limited to having struts of the cylindrically shaped end segments being longer than the struts of the cylindrically shaped intermediate segments. Since the present claims include strut lengths that can vary in any manner (claim 97) or that only differ as compared to the end struts (claim 103), the Examiner asserts that the claims read on embodiments outside that originally contemplated by the Applicants; see MPEP 2163.05 (III), which is incorporated herein by reference and disclosed the analogous issue of ranges of outside that originally contemplated. Since the present claims are not directed specifically to numerical ranges, as an alternative to the present rejection, the Examiner has also given a scope of enablement rejection below due to the fact that it may be more appropriate.

Claims 97 and 103 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a stent with struts lengths of the end segments being longer than the struts in the intermediate segments, does not reasonably provide enablement for strut lengths that can vary in any manner (claim 97) or only differ as compared to the end struts (claim 103). The specification does not

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enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. In particular, the original specification only disclosed that the cylindrically shaped end segments could be longer for "providing a more gradual transition from the native vessel to the support structure of the stent"; see page 5, lines 7-8 of the original specification. In fact, Figure 4 and page 5, lines 4-9 appear to constitute the entire disclosure with respect to varying the length of struts from one segment to another. In this disclosure, the specification is limited to having struts of the cylindrically shaped end segments being longer than the struts of the cylindrically shaped intermediate segments to provide a gradual transition from the support structure to the vessel. Since the present claims include strut lengths that can vary in any manner (claim 97) or that only differ as compared to the end struts (claim 103), the Examiner asserts that one would not be able to make and use the invention without undue experimentation; see MPEP 2164.08, which is incorporated by reference.

Allowable Subject Matter

Claims 57, 67, 79, 80, 83, 84, 89-96 and 98-102 are allowed over the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilit whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Paul Prebilic", with a stylized, cursive script.

Paul Prebilic
Primary Examiner
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